

Application Serial No. 09/513,702
Amendment Dated October 7, 2003
Reply to Office Action of July 16, 2003

REMARKS

This Response is submitted in response to the final Action Mailed July 16, 2003, wherein Claims 1, 3-4, 9, 12, 15-17, 20, 25, 27 and 29 were rejected 35 U.S.C. §103(a) as being obvious the U.S. Patent No. 5,737,474 to Aoki, *et al.* (the "Aoki patent") in view of U.S. patent No. 6,567,447 to Yoshida, *et al.* (the "Yoshida patent"), and wherein Claims 2, 5-8, 10-11, 13-14, 18-19, 21-24, 26, and 28 were rejected under 35 U.S.C. §103(a) as being obvious the Aoki patent in view of the Yoshida patent, and further in view of U.S. Patent No. 6,122,299 to DeMars, *et al.* (the "DeMars patent"). Applicants address each of the rejections below by arguing that the *prima facie* combinations lack support under U.S. law because the Yoshida patent does not qualify as prior art under 35 U.S.C. §§ 102 and 103. The 35 U.S.C. § 102(e) date of the Yoshida patent is October 3, 2000, which is after the filing date of the present application. *As this is a clear matter of law, Applicants respectfully urge consideration of these remarks after final.* Claims 1-29 are pending.

Response to the rejections of claims 1-28 under 35 U.S.C. § 103(a)

All of the Rejections of the claims rely upon the Yoshida patent, which was filed on October 3, 2000, which was prior to the change in 35 U.S.C. § 102(e) that took effect on November 29, 2000. Both the filing date and the publication date of the Yoshida patent are after Applicant's filing date of February 25, 2000. For the reasons provided below, Applicants respectfully submit that the Yoshida patent does not qualify as prior art under 35 U.S.C. §§ 102 and 103, and therefore that the rejections do not have proper support since one of the references used in all of the rejections does not qualify as prior art.

Because its filing date and publication date are both after Applicants' filing date, the Yoshida patent is not prior art. The Yoshida patent claims priority to international patent application No. PCT/JP00/00590. The international patent application was published in the Japanese language with publication No. WO00/46893 on August 10, 2000. Since the international patent application was published after Applicants' filing date of February 25, 2000 and before the change in 35 U.S.C. § 102(e) that took effect on November 29, 2000, neither the published international patent application nor the Yoshida patent, which claims priority to the international application, qualifies as prior art, see the 2003 edition of the M.P.E.P.,

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§§ 706.02(a), 706.02(f), and 2136.03. In this regard, M.P.E.P §2136.03(II)(C) specifically states:

" (C) If the international application has an international filing date prior to November 29, 2000, apply the reference under the provisions of 35 U.S.C. 102 and 374, prior to the AIPA amendments:

(1) For U.S. patents, apply the reference under 35 U.S.C. 102(e) as of the earlier of the date of completion of the requirements of 35 U.S.C. 371(c)(1), (2) and (4) or the filing date of the later-filed U.S. application that claimed the benefit of the international application;

(2) For U.S. application publications and WIPO publications directly resulting from international applications under PCT Article 21(2), never apply these references under 35 U.S.C. 102(e). These references may be applied as of their publication dates under 35 U.S.C. 102(a) or (b); (emphasis added)"

Accordingly, Applicants respectfully request that the rejections of the claims under § 103, all of which rely upon the Yoshida patent, be withdrawn. Action to that end is respectfully solicited.

The Yoshida patent can be removed as a reference because of common ownership

In addition, effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. §§ 102(e), (f), or (g) is now disqualified as prior art against the claimed invention under revised 35 U.S.C. § 103(c) if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." The revision to § 103(c) to allow exclusion of such prior art under § 102(e), (f), and (g) applies to all utility, design and plant patent applications filed on or after November 29, 1999. The present application was filed after this date, on February 25, 2000.

M.P.E.P. § 706.02(I)(2) sets out the Office's requirements for establishing common ownership for 35 U.S.C. 103(c). Sub-section II of this section of the M.P.E.P states that the following statement is sufficient evidence to establish common ownership of, or an obligation for assignment to, the same person(s) or organizations(s):

"Applications and references (whether patents, patent applications, patent application publications, etc.) will be considered by the examiner to be owned by, or subject to an obligation of assignment to the same person, at the time the invention was made, if the

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applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person."

The undersigned Agent of Record hereby states that both the present application and the Yoshida patent (U.S. Patent No. 6,567,447) were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person (The Furukawa Electric Company, Ltd.). This statement is sufficient to remove the Yoshida patent as a § 103 reference against the claims. Since the Yoshida patent is used in all of the § 103 rejections, and since it does not qualify as prior art, the *prima facie* combinations cannot be properly advanced. Accordingly, Applicants respectfully request that the Rejections of the claims under § 103 be withdrawn. Action to that end is respectfully solicited.

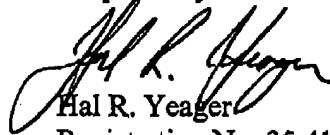
Formal request to acknowledge Applicants' claim of priority under 35 U.S.C. § 119(a)-(d)

On February 25, 2002, Applicants filed a Declaration for Patent that claimed priority to Japanese Patent Application 11-162792, filed June 9, 1999. Also on February 25, 2002, Applicants filed a certified copy of Japanese Patent Application 11-162792. Applicants respectfully request that the Examiner acknowledge Applicants' claim of priority under 35 U.S.C. § 119(a)-(d) in the next communication from the Office.

CONCLUSION

In view of the remarks made above, Applicants respectfully submit that the application is in condition for allowance and action to that end is respectfully solicited. If the Examiner should have any questions or feel that a telephone interview would be productive in resolving issues in the case, she is invited to telephone the undersigned at the number listed below.

Respectfully submitted,



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